

U.S. Application No. 09/725,048
Inventors: Roland BAZIN et al.
Attorney Docket No.: 05725.0800-00
Reply to Office Action mailed June 9, 2008

REMARKS

Claims 4-20, 24-48, 59, 61, and 62 are present in the application. Of those claims, claims 5, 9, 10, 12-20, and 24 have been withdrawn from consideration. Thus, claims 4, 6-8, 11, 25-48, 59, 61, and 62 are pending on the merits.

As an initial matter, Applicants appreciate the Examiner's reconsideration and withdrawal of the majority of the claim rejections included in the Office Action issued August 7, 2007 ("previous Office Action"). For at least the reasons outlined in detail below, Applicants respectfully request reconsideration and withdrawal of the claim rejections included in the Office Action of June 9, 2008 ("present Office Action").

I. Claim Rejection under 35 U.S.C. § 112, First Paragraph

In the present Office Action, claims 4, 6, 7, 11, 25-48, and 59-62¹ were rejected under 35 U.S.C. § 112, first paragraph. Applicants note that this claim rejection was included in the previous Office Action, and in Applicants' Appeal Brief filed February 5, 2008, Applicants submitted written remarks pointing out numerous reasons why this rejection is improper. Applicants note that the present Office Action has improperly failed to provide any response to Applicants' written remarks, even though the Office Action has repeated this rejection. Therefore, if in response to Applicants' further remarks below regarding the impropriety of this claim rejection, the Examiner maintains this claim rejection and issues a new Office Action, Applicants respectfully request that the Examiner kindly provide (1) a substantive response to Applicants' written remarks, including an explanation of the purported reasons why the claim

¹ Applicants respectfully note that claim 60 has been canceled, and thus, it cannot be properly rejected.

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rejection should not be withdrawn, and (2) designate such Office Action non-final, so that Applicants will be provided with a fair opportunity to respond appropriately.

Concerning the claim rejection under 112, first paragraph, the rejection statement asserts that subject matter included in the amendments to claims 4, 11, 25, 37, 38, 46, 48, and 59 included in Applicants' Amendment filed April 28, 2004, is allegedly not supported by the originally-filed application. Office Action at 2. In particular, the rejection statement asserts that "the origionally-filed[sic] disclosure does not provide evidence that Applicant possessed [the claim limitations 'not a fingerprint or fingerprints' and 'does not include a tooth or teeth'] at the time the application was filed." Id. Applicants respectfully submit that this rejection is improper and should be withdrawn at least because the originally-filed application clearly supports the subject matter included in the amendments to claims 4, 11, 25, 37, 38, 46, 48, and 59, for at least the reasons outlined below.

Applicants respectfully submit that the recitations in, for example, claim 4, that a "transfer image is not a fingerprint or fingerprints," and that an "external portion that [a] transfer member is placed in contact with does not include a tooth or teeth" are supported by the originally-filed application in accordance with 35 U.S.C. § 112, first paragraph. According to The Manual of Patent Examining Procedure (8th ed. rev. 6 Sept. 2007) ("M.P.E.P."), "[a]ny negative limitation or exclusionary proviso must have basis in the original disclosure[, but i]f alternative elements are positively recited in the specification, they may be explicitly excluded in the claims." § 2173.05(i) (citation omitted).

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Applicants respectfully submit that "fingerprints" and "teeth" are positively recited in the originally-filed application, and thus, the negative recitation relating to those elements is proper under 35 U.S.C. § 112, first paragraph, and is in compliance with the M.P.E.P. For example, at page 4, line 13, of the originally-filed application, the description positively recites "teeth." Moreover, teeth and nondermatoglyphic features, which include the *lack* of a fingerprint and/or fingerprints, are recited at page 8, lines 1-10, of the originally-filed description. (Applicants also respectfully note that in a Reply to Office Action filed December 5, 2005, Applicants traversed a claim rejection under 35 U.S.C. § 112, first paragraph, that relied on a flawed rationale at least similar to the flawed rationale included in the present Office Action, and the Examiner withdrew the claim rejection in the next Office Action.)

For at least these reasons, the originally-filed application supports the negative limitations relating to fingerprint(s) and teeth added to the claims in the Amendment filed April 28, 2004. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 4, 6, 7, 11, 25-48, 59, 61, and 62 under 35 U.S.C. § 112, first paragraph.

II. Claim Rejection under 35 U.S.C. § 112, Second Paragraph

In the present Office Action, claims 4, 6, 7, 11, 25-48, and 59-62² were rejected under 35 U.S.C. § 112, second paragraph. Applicants note that, like the claim rejection under § 112, first paragraph above, this claim rejection was included in the previous Office Action, and in Applicants' Appeal Brief filed February 5, 2008, Applicants

² Applicants respectfully note that claim 60 has been canceled, and thus, it cannot be properly rejected.

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submitted in written remarks pointing out numerous reasons why this rejection is improper. Applicants also note that the present Office Action has improperly failed to provide any response to Applicants' written remarks, even though the Office Action has repeated this claim rejection. Therefore, if in response to Applicants' further remarks below regarding the impropriety of this claim rejection, the Examiner maintains this claim rejection and issues a new Office Action, Applicants once again respectfully request that the Examiner kindly provide (1) a substantive response to Applicants' written remarks, an explanation of the purported reasons why the claim rejection should not be withdrawn, and (2) designate such Office Action non-final, so that Applicants will be provided with a fair opportunity to respond appropriately.

With respect to the claim rejection under § 112, second paragraph, the rejection statement asserts that claims 4, 6, 7, 11, 25-48, 59, 61, and 62 are purportedly "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Office Action at 3. In particular, the rejection statement asserts that "Applicant appears to be claiming multiple embodiments with in [sic] one claim," and requests that "Applicant carefully review each of the claims to ensure that only one disclosed embodiment is recited." Id. at 3-4. The Examiner apparently believes that independent claim 4 is indefinite because "[c]laim 4 recites a transfer member wherein the transfer member is applied to an external body portion and then later recites a transfer member (assumed to be same transfer member) is applied to an external body portion having a cosmetic product applied thereto." Id. at 3-4.

Applicants respectfully submit that (1) it is not necessarily improper under 35 U.S.C. § 112, second paragraph, for a claim to encompass more than one

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embodiment, and (2) the scope and meaning of independent claim 4 would be clear to a person having ordinary skill in the art. Concerning claim breadth, Applicants respectfully submit that according to the M.P.E.P., "[b]readth of a claim is not to be equated with indefiniteness." § 2173.04 (citing In re Miller, 441 F.2d 689, 169 U.S.P.Q. 597 (CCPA 1971)). Indeed, an example of a claim that encompasses the subject matter of more than one disclosed embodiment is commonly referred to as a "generic claim." See, e.g., M.P.E.P. § 806.04(d) (providing a definition of "generic claim"). Thus, simply because a claim is broad enough to cover more than one embodiment, does not necessarily result in that claim being improper under 35 U.S.C. § 112, second paragraph, as apparently asserted by the rejection statement.

Concerning the rejection statement's uncertainty regarding the recitation in claim 4 of "placing a transfer member in contact with an external portion of an individual," and "wherein the transfer member is placed in direct contact with an external body portion including a cosmetic product applied thereto," Applicants respectfully submit that there is nothing indefinite about this combination of recitations. The first recitation merely sets forth placing a transfer member in contact with an external portion of an individual, and the second recitation merely further defines the nature of the external body portion with which the transfer member is being placed in contact (i.e., "an external body portion including a cosmetic product applied thereto"). Thus, Applicants respectfully submit that a person having ordinary skill in the art would understand the scope and meaning of claim 4. To the extent that these comments apply to claims 6, 7, 11, 25-48, 59, 61, and 62, a person having ordinary skill in the art would understand the scope and meaning those claims for at least the same reasons.

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For at least the above-outlined reasons, the rejection of claims 4, 6, 7, 11, 25-48, 59, 61, and 62 under 35 U.S.C. § 112, second paragraph, is improper. Therefore, Applicants respectfully request reconsideration and withdrawal of this claim rejection.

III. § 103(a) Rejections of Independent Claims 4, 11, 25, 37, 38, 46, 48, and 59

The independent claims currently pending in the application are independent claims 4, 11, 25, 37, 38, 46, 48, and 59. Independent claim 4 has been rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,343,536 to Groh ("Groh"), and under § 103(a) based on based on U.S. Patent No. 6,533,971 to Stess et al. ("Stess"). Independent claim 11 has been rejected under 35 U.S.C. § 103(a) based on Stess. Independent claim 25 has been rejected under 35 U.S.C. § 103(a) based on Groh in combination with an article by J.C. Kvedar et al. entitled "Teledermatology in a Capitated Delivery System Using Distributed Information Architecture: Design and Development" ("Kvedar") and U.S. Patent No. 6,801,343 to Sheng ("Sheng"). Independent claim 37 has been rejected under 35 U.S.C. § 103(a) based on Groh in combination with Kvedar. Independent claim 38 has been rejected under 35 U.S.C. § 103(a) based on Groh in combination with Kvedar and Sheng. Independent claim 46 has been rejected under 35 U.S.C. § 103(a) based on Groh in combination with Kvedar. Independent claim 48 has been rejected under 35 U.S.C. § 103(a) based on Groh in combination with Sheng. Independent claim 59 has been rejected under 35 U.S.C. § 103(a) based on Groh in combination with Kvedar and U.S. Patent No. 6,296,880 to Murad ("Murad"). Applicants respectfully traverse each of these claim rejections because the Office Action has failed to establish that any of Applicants' independent

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claims 4, 11, 25, 37, 38, 46, 48, and 59 are *prima facie* obvious for at least the reasons outlined below.

A. Rejections of Independent Claim 4

1. Rejection of Claim 4 under § 103(a) based on Groh

Concerning the rejection of claim 4 under § 103(a) based on Groh, Groh fails to disclose or render obvious at least a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process including, *inter alia*, “placing a transfer member in contact with an external portion of an individual . . . , wherein the transfer member is placed in direct contact with an external body portion including a cosmetic product applied thereto,” as recited in independent claim 4. The rejection statement acknowledges this deficiency in Groh, conceding that Groh does not disclose “the application of the transfer member in contact with a cosmetic product applied to an external body portion.” Office Action at 6. The rejection statement asserts in a completely unsupported manner, however, that “it would have been obvious . . . to modify the device of Groh to capture facial cosmetics worn by the patient,” allegedly because “Groh is used to detect comedones, which often appear on the face,” and “[s]ince application of cosmetic products worn by the patient . . . would be captured with the comedones when the transfer member is placed in contact with the external portion, and such cosmetic would be part of the scanned image data.” Id.

Applicants respectfully disagree with the rejection statement’s unsupported obviousness assertions. Groh discloses a method of evaluating follicular biopsy

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specimens in order to count the number of comedones present in the specimen. Groh's method includes applying an adhesive to the skin, applying a microscopic slide to the skin, allowing the adhesive to set, and then removing the slide with the adhesive and the skin attached thereto. Contrary to the rejection statement's assertions about Groh, any substances (such as, e.g., at least some cosmetic products) that might interfere with the adhesive's adherence to the skin, would need to be removed from the skin to ensure that the adhesive would adhere to the skin in a manner sufficient to remove a portion of the skin when the slide is removed. Thus, Groh suggests that cosmetics should be removed from the skin prior to applying the adhesive to the skin. Moreover, because Groh's process is intended to be used to count comedones, Groh would not provide any suggestion to pick up any material other than a follicular biopsy of the skin. Additional material picked up by the slide would only hinder Groh's intended analysis of the comedones. For at least these reasons, Groh teaches away from the rejection statement's unsupported assertion about capturing cosmetic product on the slide along with the follicular biopsy specimens.

For at least the above-outlined reasons, Applicants respectfully submit that independent claim 4 is not *prima facie* obvious based on Groh. Therefore, Applicants respectfully submit that the rejection is improper and should be withdrawn, and thus Applicants respectfully request reconsideration and withdrawal the improper rejection of independent claim 4 under § 103(a) based on Groh.

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2. Rejection of Claim 4 under § 103(a) based on Stess

Turning to the rejection of independent claim 4 under § 103(a) based on Stess, Applicants respectfully submit that Stess fails to disclose or render obvious "scanning . . . with an optical image scanner to obtain scanned image data for an image," as recited in independent claim 4. Applicants respectfully submit that the rejection statement seems to be equating Stess's general disclosure of a digital scanner 51 with an "optical image scanner." Stess merely discloses using a digital scanner to obtain "digital data" relating to the dimensions of an impression shirt. (Col. 6, lines 10-31.) There is nothing in Stess providing any express or inherent teaching of the recited "scanning . . . with an optical image scanner to obtain scanned image data for an image." Stess never mentions or suggests an "optical image" or "scanned image data for an image." Indeed, Stess's digital scanner is not described as being an "optical image scanner." Furthermore, there are many digital scanners that are not optical image scanners (i.e., some scanners use technology devoid of any optical imaging). Moreover, since the purpose of Stess's disclosed digital scanner 51 relates to proper dimensioning of an orthosis, one of ordinary skill in the art would understand that Stess's scanner 51 would merely obtain dimensions of the impression shirt rather than obtaining any "image data" for an "image." For at least these reasons, Stess fails to disclose at least this subject matter recited in independent claim 4.

Moreover, the rejection statement concedes that Stess "does not explicitly teach the application of the transfer member in contact with a cosmetic product applied to an external body portion." Office Action at 14. The rejection statement apparently asserts, however, that modifying Stess's disclosed custom molded orthopedic impression shirt

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"to capture facial cosmetics worn by the patient" would have been obvious for reasons similar to those alleged by the rejection statement with respect to Groh. In particular, the rejection statement asserts that "it would have been obvious . . . to modify the device of Groh to capture facial cosmetics worn by the patient," allegedly because "Groh is used to detect comedones, which often appear on the face," and "[s]ince application of cosmetic products worn by the patient . . . would be captured with the comedones when the transfer member is placed in contact with the external portion, and such cosmetic would be part of the scanned image data." Id.

Applicants respectfully note that although the rejection statement does not indicate that the § 103(a) claim rejection based on Stess also relies on Groh, the rejection statement refers to the same unsupported rationale as the rationale supplied in purported support of the rejection of claim 4 based on Groh. See id. at 6, 14. Indeed, the rejection statement apparently copied the rationale from the rejection statement relating to the § 103(a) rejection based on Groh. Thus, for at least the reason outlined above with respect to the § 103(a) claim rejection based on Groh, Applicants respectfully submit that the § 103(a) claim rejection based on Stess is improper. In particular, Groh teaches away from the rejection statement's unsupported assertion about capturing cosmetic product on the slide along with the follicular biopsy specimens.

For at least the above-outlined reasons, Applicants respectfully submit that independent claim 4 is not *prima facie* obvious based on Stess, regardless of whether Stess is viewed individually or in combination with Groh. Therefore, Applicants

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respectfully request reconsideration and withdrawal of the rejection of independent claim 4 under § 103(a) based on Stess.

For at least the reasons outlined above, Applicants respectfully submit that independent claim 4 is patentably distinguishable from Groh and Stess, regardless of whether those references are viewed individually or as whole. Therefore, Applicants respectfully request reconsideration of withdrawal the rejections of independent claim 4 under 35 U.S.C. § 103(a) based on Groh and Stess.

B. Rejection of Independent Claim 11

Applicant's independent claims 11 was rejected under 35 U.S.C. § 103(a) based on Stess. Applicants respectfully submit that for reasons at least similar to those outlined above with respect to the rejection of independent claim 4 under § 103(a) based on Stess, the rejection of independent claim 11 is improper. For example, independent claim 11 recites, among other things, "scanning . . . with an optical image scanner to obtain scanned image data for an image" As outlined above, Stess fails to render this subject matter recited in independent claim 11 *prima facie* obvious.

Moreover, independent claim 11 also recites placing "moldable material [of a transfer member] in direct contact with the skin of [an] individual to produce, on the moldable material, the surface profile of the skin." Stess mentions a resin-impregnated, thin, elastic fabric impression shirt 27 (col. 4, lines 12-13), but the impression shirt 27 is not disclosed as being placed in direct contact with skin of an individual. In fact, Stess describes in detail the necessity of a thermal insulation layer and how to prevent direct contact with the impression shirt material. See, e.g., col. 3, lines 29-40, 58-67; col. 4,

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lines 54-67. Thus, not only does Stess fail to teach placing moldable material in direct contact with skin, as recited in claim 11, but Stess also teaches away from any such contact. Moreover, Stess does not disclose producing, on moldable material, the surface profile of skin, as recited in claim 11.

For at least these reasons, Applicants respectfully submit that independent claim 11 is patentably distinguishable from Stess. Therefore, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of independent claim 11 based on Stess.

C. Rejection of Independent Claim 25

Applicants' independent claim 25 has been rejected under 35 U.S.C. § 103(a) based on Groh in combination with Kvedar and Sheng. The rejection statement concedes that Groh "does not expressly disclose the use of a document scanner to scan the image from the transfer member." Office Action at 12. The rejection statement asserts, however, that "Sheng discloses the use of a flat bed image scanner to scan a document or picture (13) to a digitized format for conveying the image to a computer." Id. Thereafter, the rejection statement asserts that "[i]t would have been obvious . . . to have provided the process for acquiring scanned image data, as disclosed by Groh, wherein the image data is transferred to a second location and analyzed with the process taught by Kvedar et al., to allow remote and repeatable analysis of a condition of the external portion and the flat bed document scanner as taught by Sheng to enable the transfer of the image to a digitized computer format 12." Id. at 12.

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Applicants respectfully traverse the § 103(a) rejection of independent claim 25 based on rejection statement's hypothetical combination of Groh, Kvedar, and Sheng for a number of reasons. First, the rejection statement's hypothetical modification to Groh's disclosed method of using image analysis under cross-polarized light to evaluate follicular biopsy slides would defeat its disclosed principle of operation. Groh discloses that using cross-polarized light to view skin samples "is highly desirable because when the planes of polarization are adjusted properly, . . . the comedones will appear as glowing areas against the backdrop of a darker skin surface." (Col. 2, ll. 54-64.) Groh thereafter discloses that programmable image analysis hardware and software is used to capture the image and store it as determined by a machine-readable task list written by the evaluating scientist. (Col. 4, ll. 47-54.) Thus, substituting the disclosed programmable image analysis hardware and software desired by Groh with the flat image bed scanner disclosed by Sheng would defeat Groh's principle of operation by preventing a scientist from writing a machine-readable task list for the image analysis hardware and software, since Sheng does not disclose such a capability.

Second, Sheng discloses a flat bed image scanner for scanning documents, books, and pictures (col. 1, ll. 11-13), but does not disclose any scanning of a follicular biopsy slide, as disclosed in Groh. One of ordinary skill in the art would not have had any reason to use a scanner for documents, books, and pictures in the scanning of a follicular biopsy slide. For at least these additional reasons, it would not have been obvious for a skilled artisan in Groh's field to substitute Groh's follicular-biopsy-slide scanner with Sheng's flat bed image scanner for documents, books, and pictures.

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For at least the above-outlined reasons, Applicants' independent claim 25 is patentably distinguishable from Groh, Kvedar, and Sheng. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of independent claim 25 under § 103(a) based on the rejection statement's hypothetical combination of those references.

D. Rejection of Independent Claim 37

Applicants' independent claim 37 was rejected under 35 U.S.C. § 103(a) based on Groh in combination with Kvedar. In particular, although the rejection statement concedes that Groh does not disclose "the comparing of the displayed image," the rejection statement asserts that Kvedar discloses "the comparison of images for the purpose of assessing the progress of the patient's treatment (Page 362, Column 2, Paragraph 1.)" Office Action at 7. Thereafter, the rejection statement asserts that "it would have been obvious . . . to compare images as taught by Kvedar to monitor the progression of the patient's treatment and determine appropriate care methods." Id.

Applicants respectfully traverse the rejection of independent claim 37 based on the rejection statement's hypothetical combination of Groh and Kvedar. Applicants respectfully submit that the rejection statement has misinterpreted Kvedar. Kvedar does not disclose comparing images for the purpose of assessing a patient's progress, as asserted by the rejection statement. Rather, the portion of Kvedar to which the rejection statement refers in purported support of the assertions, discloses reviewing patient histories and images and rendering opinions thereabout. Nowhere in Kvedar is there any disclosure, however, relating to comparing images for the purpose of

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assessing a patient's progress. Thus, the hypothetical combination of Groh and Kvedar does not disclose all of the subject matter recited in Applicants' independent claim 37. For at least this reason, the rejection statement has failed to establish a *prima case* of obviousness.

For at least the above-outlined reasons, Applicants respectfully submit that independent claim 37 is patentably distinguishable from the rejection statement's hypothetical combination of Groh and Kvedar. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of independent claim 37 under § 103(a) based on those references.

E. Rejection of Independent Claim 38

Applicants' independent claim 38 has been rejected under 35 U.S.C. § 103(a) based on Groh in combination with Kvedar and Sheng. Applicants respectfully traverse the rejection of independent claim 38 under § 103(a) based on the rejection statement's hypothetical combination those references. Similar to independent claim 25, independent claims 38 recites "wherein the image scanner is configured in the form of a scanner for scanning documents." For reasons at least similar to those outlined above with respect to the rejection of independent claim 25 based on Groh, Kvedar, and Sheng, Applicants respectfully submit that independent claim 38 is not *prima facie* obvious based on Groh, Kvedar, and Sheng. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of independent claim 38 based on Groh, Kvedar, and Sheng.

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F. Rejection of Independent Claim 46

Applicants' independent claim 46 was rejected under 35 U.S.C. § 103(a) based on Groh in combination with Kvedar. Applicants respectfully traverse this claim rejection at least because Groh and Kvedar, regardless of whether they are viewed individually or as a whole, fail to disclose or render obvious "[a] process of evaluating a product applied to an external body portion," as recited in independent claim 46. Rather, Groh discloses a method of using image analysis under cross-polarized light to evaluate follicular biopsy slides, and Kvedar discloses sending, from a primary care provider to a dermatologist via the Internet, images of a patient's skin taken by a digital camera. Thus, neither Groh nor Kvedar discloses evaluating a product applied to an external body portion. Further, the rejection statement's assertions outlined above with respect to modifying the device of Groh to capture facial cosmetics (Office Action at 6) is unsupported and thus improper for at least the reasons outlined above with respect to the § 103(a) rejection of independent claim 4 based on Groh.

For at least these reasons, Applicants respectfully submit that the rejection statement has failed to establish that independent claim 46 is *prima facie* obvious based on Groh and Kvedar. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of independent claim 46 under § 103(a) based on the rejection statement's hypothetical combination of Groh and Kvedar.

G. Rejection of Independent Claim 48

Applicants' independent claim 48 was rejected under 35 U.S.C. § 103(a) based on Groh in combination with Sheng. Applicants respectfully traverse the § 103(a)

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rejection of independent claim 48 based on those references. The rejection statement concedes that Groh "does not expressly disclose the use of a document scanner to scan the image from the transfer member." Office Action at 9. The rejection statement alleges, however, that based on Sheng's disclosure of a flat bed image scanner for scanning documents, pictures, and books, "it would have been obvious . . . to utilize a flat bed image scanner . . . to enable the transfer of an image to a computer." Id.

For at least the reasons outlined above with respect the § 103(a) rejection of independent claim 25 based on Groh, Kvedar, and Sheng, the rejection statement has failed to establish a *prima facie* case of obviousness with respect to independent claim 48.

Contrary to the rejection statement's obviousness assertion, substituting the disclosed programmable image analysis hardware and software desired by Groh with the flat image bed scanner disclosed by Sheng would defeat Groh's principle of operation by preventing a scientist from writing a machine-readable task list for the image analysis hardware and software, since Sheng does not disclose such a capability. Moreover, Sheng discloses a flat bed image scanner for scanning documents, books, and pictures (col. 1, ll. 11-13), but does not disclose any scanning of a follicular biopsy slide, as disclosed in Groh. One of ordinary skill in Groh's art relating to analyzing follicular biopsy slides would not have had any reason to use a scanner for documents, books, and pictures in the scanning of a follicular biopsy slide. For at least these additional reasons, it would not have been obvious for a skilled artisan in Groh's field to substitute Groh's follicular-biopsy-slide scanner with Sheng's flat bed image scanner for documents, books, and pictures.

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For at least the above-outlined reasons, Applicants' independent claim 48 is patentably distinguishable from Groh and Sheng. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of independent claims 48 under § 103(a) based on the rejection statement's hypothetical combination of Groh and Sheng.

H. Rejection of Independent Claim 59

Applicants' independent claim 59 was rejected under 35 U.S.C. § 103(a) based on Groh in combination with Kvedar and Murad. The rejection statement concedes that Groh fails to disclose "analysis equipment . . . chosen from one of a corneometer, a dermal torque meter, a PH meter, and a device for measuring hydration of the skin," as recited in independent claim 59. Office Action at 8. The rejection statement asserts, however, that "it would have been obvious . . . to modify the system of Groh/Kvedar to include the use of a corneometer as taught by Murad, as a method of detecting the health of the skin in relationship to treatment methods." Id.

Applicants respectfully traverse this claim rejection. Murad discloses the use of a corneometer for measuring skin hydration. (Col. 28, ll. 53-57.) In contrast, Groh is directed to determining the number of comedones present in a follicular biopsy slide. There is no reason an artisan in Groh's field would have looked to Murad to use a corneometer to measure skin hydration at least because it is not used for measuring the number of comedones present in a follicular biopsy slide.

For at least this reason, Applicants respectfully submit that independent claim 59 is not *prima facie* obvious based on Groh, Kvedar, and Murad, regardless of whether

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those references are viewed individually or as a whole. Therefore, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of independent claim 59 based Groh, Kvedar, and Murad.

IV. Rejections of Dependent Claims

Dependent claims 6-8, 26-36, 39-45, 47, 61, and 62 were rejected under 35 U.S.C. § 103(a) based on Groh, either alone or in combination with one or more of Kvedar and Sheng, or under §103(a) based on Stess alone. At least because each of those dependent claims depends from a corresponding one of allowable independent claims 4, 25, 38, 46, and 48, those dependent claims should be allowable for at least the same reasons the corresponding independent claim is allowable. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejections of the dependent claims.

V. Conclusion

For at least the reasons set forth above, independent claims 4, 11, 25, 37, 38, 46, 48, and 59 should be allowable. Dependent claims 6-8, 26-36, 39-45, 47, 61, and 62 depend from a corresponding one of those allowable independent claims. Consequently, those dependent claims should be allowable for at least the same reasons as the corresponding allowable independent claim. Accordingly, Applicants respectfully request reconsideration of this application, withdrawal of the claim rejections, and allowance of all of pending claims 4, 6-8, 11, 25-48, 59, 61, and 62.

U.S. Application No. 09/725,048
Inventors: Roland BAZIN et al.
Attorney Docket No.: 05725.0800-00
Reply to Office Action mailed June 9, 2008

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicants' undersigned attorney at (404) 653-6559.

Applicants respectfully submit that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicants respectfully decline to automatically subscribe to them.

Please grant any extensions of time required to enter this Request and charge any additional required fees to our Deposit Account 6-0916

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 9, 2008

By: 

Christopher T. Kent
Reg. No. 48,216